

The opinion in support of the order being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 37

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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**MAILED**

Ex parte DAVID G. BIRD

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**APR 10 2002**

Appeal No. 2002-0393  
Application No. 08/862,039

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PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

**ORDER**

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Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief  
Administrative Patent Judge, and NASE, Administrative Patent Judge.

NASE, Administrative Patent Judge.

This is an order under 37 CFR § 1.196(d). 37 CFR § 1.196(d) provides:

The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement.

Thus, 37 CFR § 1.196(d) authorizes the Board of Patent Appeals and Interferences (Board) to require an appellant to clarify the record by addressing any matter deemed appropriate for a reasoned decision on the appeal.

### BACKGROUND

The sole issue on appeal is whether claims 28 to 59 have been properly rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The appellant filed their appeal brief on January 24, 2001 (Paper No. 31).

The case of Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), was decided on July 25, 2001.

In Pannu the Court in discussing the recapture rule stated that "[o]n reissue, [patentee] is estopped from attempting to recapture the precise limitation [patentee] added to overcome prior art rejections." 258 F.3d at 1372, 59 USPQ2d at 1601.


### ORDER

Pursuant to 37 CFR § 1.196(d), the appellant is required to file a Supplemental Appeal Brief to address the impact the Pannu decision has on the rejection before us in this appeal.

The appellant is given a non-extendable time period of **TWO MONTHS** from the mailing date of this order for response thereto. Failure to respond within this **TWO MONTH** time period will result in the dismissal of the appeal. Since there are no allowed claims, the dismissal of the appeal will result in the abandonment of this application.<sup>1</sup>

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

  
GARY V. HARKCOM  
Vice Chief Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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<sup>1</sup> See MPEP § 1215.04.

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DONALD S. DOWDEN  
COOPER & DUNHAM  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

JVN/tl